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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/291,294	04/14/1999	CRIS T. PALTENGHE	CITI0131-US	1910

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EXAMINER
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NORMAN, MARC E

ART UNIT	PAPER NUMBER
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3744

DATE MAILED: 03/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/291,294

Applicant(s)

PALTENGHE ET AL.

Examiner

Marc E. Norman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 December 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7-12,14,19,20,22-24,28-32,34,38-41,48-50,72,73,75-81,84 and 85 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims pending in the application are 1,3-5,7-12,14,19,20,22-24,28-32,34,38-41,48-50,72,73,75-81,84 and 85.

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## DETAILED ACTION

### *Remarks*

Applicant's remarks in paper 11 (see page 6) stated that claims 1, 3-12, 14-32, 34, 38-41, 44-56, 58-62, 64-67, and 69-92 are pending in the application. However, upon review of the prosecution history, the Examiner finds claims 1, 3-5, 7-12, 14, 19, 20, 22-24, 28-32, 34, 38-41, 48-50, 72, 73, 75-81, 84, and 85 to be pending. The Examiner requests that the Applicant also review the prosecution history to verify that this is correct.

### *Response to Arguments/Amendments*

Applicant's arguments/amendments filed 28 December 2001 have been fully considered but they are not persuasive. Applicant made several substantive amendments to independent claims 1, 32, 41, and 81. Each of the amendments is addressed in turn below.

#### Claim 1

*"storing the data for the owner consisting at least in part of information relating to the owner's estate"*

The fact that the data consists of information relating to the owner's estate does not carry patentable weight since the information itself is never functionally applied within the claim, and is thus is merely a matter of nonfunctional descriptive material.

*“the virtual wallet function residing at least in part on a server of a trusted third party”*

As discussed in the previous Office Action (see paper #9, pages 2-3), the term “virtual wallet” is an extremely broad term which, for the purposes of patentability, does not clearly define the metes and bounds of the invention. The fact that the function resides on the server of the trusted third party does not overcome this problem. Further, note that Fischer teaches the secret private key store as being on the trusted third party’s computer (Figure 1).

*“automatically assigning a primary aspect of a secret access device for the virtual wallet application to the owner by the virtual wallet application”*

Note the discussion of paper #6, page 3 regarding assigning the secret device. As discussed, assigning a secret access device as taught by Public Legal Education Society of Nova Scotia is a common activity in the banking industry. The fact that it is assigned automatically (or within a computer-based context) does not in itself lend patentable weight. Also, due to the indefiniteness surrounding the term “virtual wallet,” the fact that the assigning is done for and by the virtual wallet function does not lend patentable weight. Finally, the concept of assigning and escrowing different access means is again discussed in paper #6, page 3. Simply defining the access device as having “primary” and “secondary” aspects is not in itself patentably significant.

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*“automatically escrowing a secondary aspect of the secret aspect of the secret access device for the virtual wallet application by the virtual executor function conditioned on the occurrence of an event that renders the owner incapable of acting on the owner's behalf”*

See discussion of the previous quote. Further, regarding the event being one that renders the own incapable of acting on the owner's behalf, Public Legal Education Society of Nova Scotia (see page 9) teaches access being based on the death of the owner.

*“receiving verification of the occurrence of the event by the trusted third party from a personal representative of the owner upon the occurrence of the event”*

See Public Legal Education Society of Nova Scotia, page 9, regarding providing “a death certificate and proof that you are the legal representative of the deceased.”

*“accessing the stored data by the trusted third party on behalf of the owner's personal representative with the escrowed secret access device”*

Again, see Public Legal Education Society of Nova Scotia, page 9, regarding the bank providing access to the legal representative.

Claim 32

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*“storing the data for the owner consisting at least in part of an electronic copy of the owner’s will on a virtual wallet application for the owner, the virtual wallet application residing at least in part on a server of a trusted third party and having a virtual executor function”*

Again, the fact that the data consists of an electronic copy of the owner’s will does not carry patentable weight since it is merely a matter of nonfunctional descriptive material, since the information itself is never functionally applied within the claim. Note the discussions above regarding the “virtual wallet” residing on a trusted third part server. See the discussion of paper #9, pages 2-3 regarding the issue of a virtual executor function.

*“accessing the stored data on the virtual wallet application...assigning the secret device by the virtual wallet application”*

See discussion above with regard to claim 1.

*“automatically escrowing...”*

Changing the word “storing” to “escrowing” does not lend patentable significance to the claim.

*“an event comprising one of the owner’s death and the owner’s incompetence”*

See discussion above with regard to claim 1.

Claims 41 and 81

Each of the amendments to these claims have already been discussed above with regard to claims 1 and 32.

Applicant's Arguments

Applicant provides a paragraph summary of the invention along with brief summaries of the Fischer and Rosen patents, and generally asserts that neither Fischer nor Rosen teaches or suggests the method and system for securely storing estate-related data for an owner as contemplated by Applicant's claimed invention. To the contrary, the Examiner submits that a thorough analysis of Applicant's claims has been provided and that, in light of the teachings of Fischer and Rosen, along with the discussion of common banking practices (as highlighted by Public Legal Education Society of Nova Scotia) (see paper #6), Applicant's invention is indeed rendered obvious over the prior art. Applicant has not directly addressed the Examiner's arguments.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person



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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-5, 7-12, 14, 19, 20, 22-24, 28-32, 34, 38-41, 48-50, 72, 73, 75-81, 84, and 85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer in view of Rosen.

In view of the discussion provided above regarding Applicant's amendments and arguments, the previous rejections of these claims are carried forward and maintained.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc E. Norman whose telephone number is 703-305-2711. The examiner can normally be reached on Mon.-Fri., 8:00-5:30, with first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Denise Esquivel can be reached on 703-308-2597. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MN

March 13, 2002

  
DENISE L. ESQUIVEL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700